

REMARKS

Applicants thank Examiner Morris for the courtesies extended to Applicants' representative during an interview on July 8, 2009. During the interview, Applicants' representative and the Examiner discussed the Final Office Action including cited U.S. Patent No. 6,502,756 to Fähraeus ("Fähraeus"). Applicants' representative explained why the claims distinguish over the cited references. The Examiner appeared to appreciate the differences yet suggested clarifying claim amendments along the lines of those presented herein to further emphasize the differences. While Applicants do not believe the claim amendments proposed herein are necessary to render the claims patentable, based on the interview and in order to expedite the application process, Applicants present amendments that further place the application in condition for allowance. Because the amendments presented herein are of a relatively brief, clarifying nature, it is respectfully requested that the Examiner enter this Amendment after Final, and pass the application to allowance.

Specifically, Applicants propose amending independent claims 1, 23, 30, 33, 34, 41, 45, and 51 to emphasize, *inter alia*, that the recited graphic information (claims 1, 23, 30, 33, 34, 41, 45) or graphical object (claim 51) is "user-readable" and "configured for application to a substrate"-- distinctions which, in combination with the other unique recitations of the claims, distinguish the invention from the cited art. Applicants also propose amending claim 51 to clarify that the assignment of position data is performed in response to the selection of at least one graphical object.

In the final Office Action dated May 13, 2009, the Examiner rejected claims 1-16, 18-21, 23, 24, 26-38, 40-45, and 47-53 under 35 U.S.C. § 103(a) as being unpatentable

over WO 01/48678 A1 to Andersson et al. ("Andersson") in view of *Fåhraeus*. The Examiner also rejected claims 17, 22, 25, 39, and 46 under 35 U.S.C. § 103(a) as being unpatentable over *Andersson* in view of *Fåhraeus* and further in view of U.S. Patent No. 6,958,747 B2 to Sahlberg et al. ("Sahlberg").

§ 103 Rejection of claims 1-16, 18-21, 23, 24, 26-38, 40-45, and 47-53

Claim 1, as amended, recites an information processing system including, amongst other elements, "an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, and to provide allocation data which associates said assigned position data with the current graphical object . . . wherein the allocation unit is commanded to assign the position data in response to a selection of the current graphical object." In the Final Office Action, the Examiner concedes that "Andersson does not teach an allocation unit." Office Action at 3.

Fåhraeus, considered alone or in combination with *Andersson*, also does not teach or suggest a combination including the claimed allocation unit. *Fåhraeus* teaches "[a] product which is intended to be used in connection with the recording of information has a surface on which there are a plurality of information alternatives which each have an associated code area." *Fåhraeus* at Abstract. The Examiner cites to column 18, line 62 through page 19, column 25 and Figure 8 of *Fåhraeus* as an alleged teaching of the claimed allocation unit. However, in the cited portion and as shown in Figure 8, *Fåhraeus* discloses that "[i]n a first step 81, the software prints the position code on a sheet of paper," "[i]n a second step 82, the user enters the various information alternatives via the keyboard of the computer," then "the connection between positions on the sheet of paper and information alternatives is stored," after which "the user

places the sheet in the printer and the information alternatives entered via the keyboard are printed on the sheet." See *Fåhraeus* col. 18, ll. 66-67, col. 19, ll. 5-6, 16-21.

Thus, unlike the system of claim 1 of the present application, in *Fåhraeus* assignment of position data is unrelated to the selection of a graphical object. This distinction is made even clearer because *Fåhraeus* discloses that the position code can be written on the sheet before or after applying the information alternatives (see *Fåhraeus* at col. 6, ll. 37-39) -- in other words, the assignment of position code in *Fåhraeus* is independent from the selection of the information alternatives. This is most certainly not a teaching or suggestion of "an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, and to provide allocation data which associates said assigned position data with the current graphical object . . . wherein the allocation unit is commanded to assign the position data in response to a selection of the current graphical object" as recited in claim 1.

Moreover, *Fåhraeus*'s indication that "[t]he specific coordinate area can be preset in the program or be selected within certain limits" (*Fåhraeus*, col. 19, ll. 3-4) does not teach or suggest the claimed "assign[ment] on command" of "position data in response to a selection of the current graphical object." Rather, the setting or selection of a coordinate area does not teach or suggest the claimed commanding of the assignment of position data in response to the selection of a *graphical object*. In addition, the fact that position code is printed on a sheet in *Fåhraeus* does not teach or suggest that a selection of a graphical object was necessarily performed or is obvious, much less that an assignment of position data was performed in response to the selection.

Therefore, Applicants believe that the claims, as they stood before this submission, fully distinguish over the art of record. Nevertheless, following the interview, and in an effort to expedite prosecution without the need for appeal, Applicants propose amending claim 1 to clarify that the graphical objects are characterized by user-readable graphic information that is configured for application to a substrate. As discussed in the interview, the combination of *Andersson* and *Fahraeus* does not teach or suggest the unique combination of claim 1, including at least the claimed allocation unit that assigns position data in response to a selection of a graphical object characterized by user-readable graphic information and configured for application to a substrate.

In addition, in order for an obviousness rejection to stand, the Office Action must, yet has not, properly determined the scope and content of the prior art and properly ascertained the differences between the prior art and the claimed invention. Furthermore, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and Applicants request that the Examiner withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

The remaining independent claims (23, 30, 33, 34, 41, 45, and 51), although each different in scope from claim 1 and from each other, are amended herein to include recitations similar to those added to claim 1, in addition to including recitations that independently distinguish each claim from the cited art. For example, independent claims 23 and 30 recite unique combinations including, amongst other features "an

allocation unit which assigns, on command in response to a selection of a current graphical object . . . , position data for the current graphical object from a position data bank." Claim 51, as amended by Applicants' proposed amendment, recites "a processor configured to assign position data from the second memory to the at least one graphical object in response to the selection by the user." For the reasons discussed above in connection with claim 1, *Andersson* and *Fähraeus*, considered alone or in combination, do not teach or suggest the unique combination recited in claims 23, 30, 33, or 51.

Similarly, although different from claims 1, 23, 30, 33, and 51, independent claim 34 recites a method including a step of "assigning from a position data bank position data for the current graphical object in response to the selection of the current graphical object." For the reasons discussed above in connection with claim 1, *Andersson* and *Fähraeus*, considered alone or in combination, do not teach or suggest the unique combination recited in claim 34. Independent claims 41 and 45 are different in scope from claim 34 and from each other, but also include similar recitations.

Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 23, 30, 33, 34, 41, 45, and 51 for at least reasons similar to those provided above with respect to claim 1. Therefore, Applicants respectfully request that the Examiner also withdraw the rejection of independent claims 23, 30, 33, 34, 41, and 45 under 35 U.S.C. § 103(a).

Dependent claims 2-16, 18-21, 24, 26-29, 31, 32, 35-38, 40, 42-44, 47-50, 52, and 53 depend from one of independent claims 1, 23, 30, 33, 34, 41, and 45, and are at least allowable over the cited art based on their dependencies on allowable

independent claims. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of the dependent claims under 35 U.S.C. § 103(a).

§ 103 Rejection of claims 17, 22, 25, 39, and 46

As discussed above in connection with claim 1, *Andersson* and *Fåhraeus* do not teach or suggest the unique combination including, amongst other elements, “an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, and to provide allocation data which associates said assigned position data with the current graphical object . . . wherein the allocation unit is commanded to assign the position data in response to a selection of the current graphical object.” For similar reasons and those reasons discussed above, *Andersson* and *Fåhraeus* also do not teach the allocation unit as claimed in claims 23, 34, and 45. *Sahlberg* does not cure this deficiency. The Examiner has agreed with Applicants that *Sahlberg* does not teach assigning position data on command. Office Action at 2.

As noted in connection with the earlier § 103 rejection, in order for an obviousness rejection to stand, the Office Action must, yet has not, properly determined the scope and content of the prior art and properly ascertained the differences between the prior art and the claimed invention. Furthermore, the Office Action has failed to clearly articulate a reason why claims 17, 22, 25, 39, and 46, which each depend from one of claim 1, 23, 34, or 45, would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and Applicants request that the Examiner withdraw the rejection of these dependent claims under 35 U.S.C. § 103(a).

Conclusion

Applicants respectfully request entry of this Amendment under 37 C.F.R. § 1.116, placing claims 1-53 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 23, 30, 33, 34, 41, 45, and 51 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Further, Applicants respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that entry of this response permits Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

The Office Action contains characterizations of the invention and the cited art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Through this Amendment, Applicants have attempted to place this application in condition for allowance. If the Examiner foresees any impediments to allowance, the undersigned would welcome a phone call from the Examiner to resolve any outstanding issues.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 13, 2009

By: Kay Henry Hill
Kay H. Hill
Reg. No. 62,833
(202) 408-4000